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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/582,442	06/26/00	NISHIDA	H 1110-0271P

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EXAMINER

TRUONG, T

ART UNIT	PAPER NUMBER
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1624

*4*

DATE MAILED: 11/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/582,442

Applicant(s)  
Nishida Et. Al.

Examiner  
Tamthom N. Truong

Group Art Unit  
1624



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-16 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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*Lack of Unity.*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 C.F.R. 1.499, applicants are required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-9 (in part), 11-14 (in part), and 16, drawn to compounds, compositions, and methods of treatment using **formula I** wherein **X** is **-CH**, and **Y** represents **-N** while one of  $G_1$  to  $G_3$  is **N** and  $G_4$  is **-CH**. Also compounds of **formula (VI)**.
- II. Claims 1-4 (in part), and 10-14 (in part), drawn to compounds, compositions, and methods of treatment using **formula I** wherein both **X** and **Y** represent **N**, and either,  

All of  $G_1$  to  $G_4$  represent **-CH**, or

One of  $G_1$  to  $G_4$  represents **N** while the others are **-CH**.
- III. Claim 15, drawn to **intermediates** (i.e., **formula (IV-b)**).
- IV. Claims 1-4 (in part), and 10-14 (in part), drawn to compounds, compositions, and methods of treatment using **formula I** wherein **X**, **Y**,  $G_1 - G_4$  are drawn to the remaining subject matter. Further restriction and election of species will be required if this group is elected.

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discussed above, the instant invention clearly lacks unity according to PCT 13.2. Accordingly, restriction under 35 U.S.C. 121 and 372 is deemed necessary.

Should applicant traverse on the ground that species of all groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the invention unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C 103(a) of the other invention.

A telephone call was made to Mr. Gerald Murphy in October to request an oral election to the above restriction requirement, but a written restriction was requested.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom (or Tam) N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on Monday through Friday from 6:30 a.m. to 3:00 p.m.

The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong / 11-3-00



**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**



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